DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-3, 5-8, 11, 12 and 14 of the current Application are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 10, 11, 13-18, 20 and 21 of copending Application No. 10/535,488. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in copending Application No. 10/535,488 are drawn to substantially the same invention and encompass the claimed invention of the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claims 1-8 and 11-14 of the current Application are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/535,489. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in copending Application No. 10/535,489 are drawn to substantially the same invention and encompass the claimed invention of the current application. Since claim 1 of the current Application includes a starch-containing material and claim 1 of copending Application No. 10/535,489 may contain tomato powder, which is a starch containing material, these claims are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-5, 8 and 14 of the current Application are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/587,730. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in copending Application No. 10/587,730 are drawn to substantially the same invention as the claims in the current Application. Since claims 1 and 5 of the current Application also limit the ratio of a H3 compound, such as palmitic acid or palm oil, to a H2U compound, such as stearic acid, fully hardened rape fat, soybean oil or sunflower oil, these claims are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte*

Hasche, 86 USPQ 481 (Bd. App. 1949).

Regarding claims 1 and 4, the phrase "preferably" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. *See* MPEP § 2173.05(d).

Regarding claims 1, 3 and 4, the use of the parenthesis to further define H3 and H2U renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Examiner suggests stating the definition as part of the claim and placing the abbreviations H3 and H2U in parenthesis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cain et al. US 5,718,938.

Cain discloses a bakery fat composition and food products containing the composition comprising a mixture of triglycerides. Column 1, lines 35-48. Cain's invention contains mixtures of saturated fatty acids having triglycerides with 16 or more carbon atoms and triglyceride fatty acids with 16 or more carbon atoms with cis-

unsaturated fatty acids. Column 2, lines 18-43. The invention contains 5-80 wt. % of fat, 0-50 wt. % of water, 0-4 wt. % of salt, 20-80 wt. % of flour and 0-15 wt. % of leavening agents. *Id.* Cain describes a triglyceride ingredient B that is the same ingredient as Applicants H3 and an ingredient A that is the same as Applicants H2U. Column 3, lines 16-31. These ingredients are combined to form a fat mixture containing 10-75 wt. % H3 or S3 and 0-90 wt. % H2U or SUS. *Id.*; Column 4, line 62-Column 5, line 34. Therefore, H3+H2U may incorporate up to 100 wt. % of the fat ingredient. Also the percentages of H and U, and the ratio of H3:H2U may be any varying range within 10-75 wt. % H3 or S3 and 0-90 wt. % H2U or SUS of the fat composition.

Cain also teaches the use of palm oil and palm oil stearin as the triglyceride mix. Column 4, lines 18-29; Column 4, line 62- Column 5, line 34. Since palm oil is 35-45 % palmitic acid (Encyclopedia Britannica), Cain's fat composition may also contain between 30-70 wt % palmitic fatty acid. Cain teaches that the composition is blended until it becomes a homogenous mass and then it is combined with additional ingredients to create dough.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cain et al. US 5,718,938, as applied to claims 1 and 9 above, in view of Jarworski et al. US 4,126,710.

As stated above, Cain discloses a bakery fat composition and food products containing the composition comprising a mixture of triglycerides. Column 1, lines 5-48. Cain teaches that the composition is blended until it becomes a homogenous mass and then it is combined with additional ingredients to create dough. Column 4, line 53-Column 5, line 55. Cain does not specifically teach the addition of wheat flour, barley flour, rice flour, etcetera, to the homogenous mass of fat mixture in order to create a roux, a paste, flakes, cubes or particulate matter.

Jaworski et al. teaches a process for preparing a sauce mix. Jarworski describes prior art in which triglycerides of desired characteristics are melted with any cereal flour/starch, such as wheat flour, and other additional ingredients, such as salt, flavorings, colorants and spices. Column 1, line 33-Column 2, line 30; Column 3, line 65-Column 4, line 35; Example I. The resultant product may be dough-like, pasty or brittle and may be shaped into bars, blocks, flakes, rods, etcetera. *Id.* The mixture of triglyceride and flour may also be used to form a roux. Column 2, lines 23-30.

Since Cain discloses the long-chain triglycerides of fatty acids, flour and water composition of the invention claimed and Jaworski teaches a sauce mix containing triglyceride, cereal flour and additional ingredients, it would have been obvious at the time this invention was made for a person of ordinary skill in the art to use the process

taught by Jaworski to form a roux with any appropriate cereal flour and Cain's disclosed bakery fat composition. The resultant product may be in the form of a particulate flake, cube or granule.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lynnette Kelly whose telephone number is 571-270-3472. The examiner can normally be reached on Monday - Friday EST (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Tarazano can be reached on 571-272-1550. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gwendolyn Blackwell/
Primary Examiner, AU 1794

Y. Lynnette Kelly
Examiner
Art Unit 4174

/Y. Lynnette Kelly/

Examiner, Art Unit 4174